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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,473	08/29/2001	James R. Hornsby	6871.01	6470

25763 7590 05/05/2003

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MINNEAPOLIS, MN 55402-1498

EXAMINER

FRANCIS, FAYE

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/941,473

Applicant(s)

HORNSBY ET AL.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the dispensing surface in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the requirement in claim 3 that "the arcuate portion of the housing positioned to allow the pump roller to pinch the feed tube to create the vacuum".

The disclosure is objected to because of the following informalities: on page 8 lines 4, 7 and 11 of the specification reference characters "42" and "46" have been used to designate "nozzle" and "ring". Additionally, on page 9 lines 1, and 5 of the specification reference characters "54" has been used to designate "fan blade" and "funnel".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-8 and 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the outside air" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 7 and 19-20 are drafted in such a way that it appears to be entirely functional. The claim is vague and indefinite because, the additional structure sought to be added to claim 1 or encompassed in this dependent claim cannot be determined.

Claim 14 is indefinite since all that the applicant considers to be encompassed by the phrase "a capillary pump" cannot be determined.

Claim 15 is indefinite because it is not clear what the phrase "a fanning tip" is intended to encompass.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lei.

Lei discloses in Figs 1-6, a bubble making apparatus comprising: a dispensing opening, a sleeve [tunnel 26] mounted within the dispensing opening and having a dispensing surface, a tank [reservoir 16] mounted on the housing to contain a liquid

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capable of producing bubbles, trigger assembly 12, a pump 14 mounted on the housing and connected to the tank by a tube 22, a source of blown air 24. Additionally, Lei further discloses a film producing mechanism 18 including a dispensing ring located adjacent to the dispensing surface and movable parallel to the dispensing surface.

Since the device disclosed in the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all the claimed functions including the ability to distribute a thin film of the liquid across the dispensing surface.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-7 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lei in view of Bart.

Lei discloses most of the features of these claims as applied to claims 1 and 9 but does not disclose a light source/ means for illuminating bubbles as recited in claims 2 and 10, the light source is an LED as recited in claim 5, the light source flashes as recited in claims 6 and 22 and means for adjusting the means for illuminating as recited in claim 12.

Bart teaches the concept of providing a light source/ means for illuminating bubbles [bulb 29] in a bubble making apparatus. It would have been obvious to one having ordinary skill in the art at the time invention was made to modify the apparatus

as disclosed by Lei to have the light source/ means for illuminating bubbles in order to make the device usable by a child at night as well as during the day.

With respect to the LED light source, the light source flashes and means for adjusting the means for illuminating. It would have been obvious to further modify the apparatus as disclosed by Lei to have the flashing LED light source in order to make the device more fun to play with. Additionally, it would have been obvious to further modify the apparatus as disclosed by Lei to include means for adjusting the means for illuminating in order to make the device more interesting to play with.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lei in view of DeMars.

Lei discloses most of the features of this claim as applied to claim 1 including a recycling funnel [compartment 46] and a recycling tube 44 interconnecting the recycling funnel and the tank but does not a one-way valve disposed within the recycling tube to prevent fluid flow in a direction from the tank to the recycling funnel.

DeMars teaches a desirability, in the same art of bubble making toys to, to have one-way valve in the recycling system of a bubble making toy to prevent fluid flow in a direction from the tank to the exterior of the housing. It would have been obvious to further provide the device of Lei with the one-way valve as taught by DeMars and disposed it within the recycling funnel in order to prevent leakage.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were

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made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

***Allowable Subject Matter***

11. Claims 2-3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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